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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,715	02/01/2000	Hideyuki Miyata	1480.1003	5208

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EXAMINER

PASCAL, LESLIE C

ART UNIT

PAPER NUMBER

2633

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/495,715

Applicant(s)

MIYATA ET AL.

Examiner

Sherif R. Fahmy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8,10 and 24-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,10,24-26,29,30,33,34 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8, 10, 29, 33, 34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Chiaroni.
3. Regarding all the claims, it is noted that the light input into the modulator is also output from the modulator (having undergone modulation). Accordingly, attenuating the light input into the modulator is considered identical to attenuating the light output from the modulator.
4. Regarding claim 29, Chiaroni teaches  
An optical modulator modulating an input light in accordance with a modulation signal; and  
Means for attenuating intensity of the input light in accordance with intensity of the modulation signal.  
(see for example col. 2- lines 39-47).
5. Regarding claim 33, Chiaroni teaches  
An optical modulator modulating an input light in accordance with a modulation signal, to thereby output a modulated light; and

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Means for attenuating intensity of the modulated light output from the optical modulator in accordance with intensity of the modulation signal.

(see for example col. 2- lines 39-47).

6. Regarding claim 34, Chiaroni teaches

Optically modulating an input light in accordance with a modulation signal; and attenuating intensity of the input light in accordance with intensity of the modulation signal.

(see for example, col. 2- lines 39-47).

7. Regarding claim 37, Chiaroni teaches

Optically modulating an input light in accordance with a modulation signal, to thereby output a modulated light; and

Attenuating intensity of the modulated light output from said optical modulating in accordance with intensity of the modulation signal.

(see for example col. 2- lines 39-47).

8. Regarding claim 8, Chiaroni teaches

Optical modulating means for modulating input light in accordance with a modulation signal to be transmitted; and

Regulating means for regulating the intensity of light which is transmitted through an optical transmission line from said optical modulation means, wherein said regulating means is an optical attenuating means for attenuating the intensity of light entered to an input port of said optical modulating means in accordance with the intensity of said modulating signal. (It is noted that light output from the modulator is light that was input to the modulator through an input port)

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(see for example col. 2- lines 39-47).

9. Regarding claim 10, Chiaroni teaches

Optical modulating means for modulating input light in accordance with a modulation signal to be transmitted; and

Regulating means for regulating the intensity of light which is transmitted through an optical transmission line from said optical modulation means, wherein said regulating means is an optical attenuating means for attenuating the intensity of light exit from an output port of said optical modulating means in accordance with the intensity of said modulation signal. (it is noted that the attenuating means in Chiaroni attenuate the light exit from an output port of the modulator).

(see for example col. 2- lines 39-47).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 24, 25, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiaroni.

12. Regarding all the claims, it is noted that the light input into the modulator is also output from the modulator (having undergone modulation). Accordingly, attenuating the light input into the modulator is considered identical to attenuating the light output from the modulator.

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13. Regarding claims 24, 25, 26 and 30, the claims largely correspond to claims 8, 10, 29 and 33 respectively, the difference being that claims 24 and 25 specify that the attenuating means is an attenuator. Chiaroni does not specify using an attenuator. However, Chiaroni specifies attenuating and attenuators are notoriously used in the art to attenuate optical signals. At the time the present invention was made, it would have been obvious to one having ordinary skill in the art to use an attenuator since it is readily available means for attenuating, and is conventionally used in the art.

#### ***Allowable Subject Matter***

14. Claims 27, 28, 31, 32, 35, 36, 38 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: Regarding all the claims, Chiaroni teaches attenuating when the modulating signal is a high level, not when it is below a predetermined level. Regarding claims 28, 32, 36, and 39, Chiaroni does not teach that unmodulated input light should be prevented from propagating downstream.

#### ***Conclusion***


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherif R. Fahmy whose telephone number is 703-305-8088. The examiner can normally be reached on 8:30AM-6:00PM(Mo-Th) 8:30AM-5:00PM(2nd & 4th Fr).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 703-305-4729. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4800.

SRF

  
LESLIE PASCAL  
PRIMARY EXAMINER